

PATENT
ATTY. DOCKET NO. / ELYN-26

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

**Ex parte
Appeal No. _____**

Serial No.: 09/754,927
Filed: January 4, 2001
Group Art Unit: 3621
Examiner: Cristina O. Sherr
Applicant: Randy L. Prakken et al.
Title: EMBEDDED LICENSE DATA FILE DISTRIBUTION AND
PROCESSING SYSTEMS

Cincinnati, Ohio 45202

October 9, 2008
Via EFS-WEB

APPEAL BRIEF

This brief is in furtherance of Applicant's Notice of Appeal filed June 9, 2008, appealing the decision of the Examiner dated January 9, 2008 finally rejecting claims 1-26. A copy of the claims appears in the Appendix to this brief.

Certificate of Electronic Transmission

I hereby certify that this correspondence and any enclosures are being electronically transmitted to the Examiner listed above at the U.S. Patent Office on the date indicated below.

/ Thomas W. Humphrey /

October 9, 2008

Thomas W. Humphrey

Date

Reg. No. 34,353

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Real Party In Interest

The real party in interest in this appeal is Swiftview, Inc, an Oregon corporation having a place of business at 7565 S.W. Mohawk, Tualatin, Oregon 97062.

Related Appeals and Interferences

There are no such appeals or interferences.

Status of Claims

Total Number of Claims in the Application

Claims in the application are 1-26.

Status of all the Claims

1. Claims cancelled: NONE
2. Claims withdrawn from consideration but not cancelled: NONE
3. Claims objected to: NONE
4. Claims allowed or confirmed: NONE
5. Claims rejected: 1-26

Claims on Appeal

The claims on appeal are Claims 1-26.

Status of Amendments

There are no amendments pending.

Summary of Claimed Subject Matter as to Independent Claim 1

Independent Claim 1 is described in the specification on page 6, lines 9-27, and Fig. 1, reference numbers 36, 37, 38 and 40 of the drawings.

In the invention as recited in claim 1, a licensed server includes “stamping” means that embeds a “license stamp” in a data file before forwarding it to a destination computer, the license stamp indicating that the file is from a licensed server. Processing software in the destination computer is adapted to process a received data file to carry out an action with respect to the data file only when the data file includes the license stamp indicating that a licensed server forwarded the file.

Summary of Claimed Subject Matter as to Independent Claim 12

Independent Claim 12 is also described in the specification on page 6, lines 9-27, and Fig. 1, reference numbers 36, 37, 38 and 40 of the drawings.

In the invention as recited in claim 12, a data file distribution system includes a source computer with server software with a “license stamping means” that embeds a “license stamp” in a data file before forwarding it to a destination computer, the license stamp indicating that the file is from a licensed server. Processing software in the destination computer is adapted to process a received data file to carry out an action with respect to the data file only when the data file includes the license stamp indicating that a licensed server forwarded the file.

Summary of Claimed Subject Matter as to Independent Claim 23

Independent Claim 23 is also described in the specification on page 6, lines 9-27, and Fig. 1, reference numbers 36, 37, 38 and 40 of the drawings.

In the invention as recited in claim 23, a data file distribution system includes a means for providing a data file and a second means for receiving the file. A third means receives the file from the first means, embeds an encoded license in the data file and forwards the file with the encoded license to the second means. The second means checks the received file to determine whether it contains an encoded license, and processes the file only if the file includes an encoded license.

Grounds of Rejection

Whether the subject matter of any of claims 1-26 are obvious in light of Stefik U.S. Patent 5,629,980.

Argument

The Stefik reference cited by the Examiner is directed to a server that is allowed to forward a digital work (such as a data file or software) only to those destination computers that are authorized to receive the digital work. Stefik teaches at col. 6, lines 5-29 that when a destination computer (repository 2) requests a digital work from a server computer (repository 1) storing the digital work, the server determines whether the destination computer is authorized to receive the work by checking the “usage rights” that the work’s creator attached to the digital work, and refrains from forwarding the work to the requesting computer unless the usage rights indicate the destination computer is authorized to receive the work.

The Examiner’s rejection has pointed to text at col. 13 lines 24-40 of Stefik. That text does not relate to the handling of files by the Stefik repositories, but rather, relates to the upgrading of the software of the repository itself. Specifically, that section of Stefik indicates that when software is delivered to a repository the repository tests a certificate attached to the software to “authenticate that the software has been tested by an authorized organization”. If there is no such certificate or if the “repository that generated the certificate is not known to the repository receiving the software, then the software cannot be installed.”

This upgrade process is notably not the same as the file transfer process implemented by Stefik. In particular, the Stefik file transfer process blocks the forwarding of works based on access rights, whereas the upgrade process blocks the installation of server. Both processes, however, are different from the claimed invention.

Argument - Rejections under 35 U.S.C. § 103

As noted, claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US 5,629,980). Applicant submits that Stefik is clearly different from and does not suggest the claimed invention.

As noted above, Stefik is very different from the claimed invention, because Stefik seeks to preclude or constrain access to works at the repository, and refrains from forwarding works to a receiver in the absence of usage rights or a “ticket”. In contrast, the invention as recited in claims 1, 12 and 23 uses a server to embed a “license stamp” in a data file before forwarding. Processing software in the destination computer is adapted to process a received data file to carry out an action only if the file includes the license stamp indicating that a licensed server forwarded the file. This is quite different from Stefik in many ways:

1. The meaning of the “license stamp” is different from the meaning of the “ticket”. The “license stamp” indicates a file was forwarded by a licensed server, whereas a ticket (punched or unpunched) indicates the right of a destination computer to access the work.
2. The entity that uses the “license stamp” is different from the entity that uses a “ticket”. Stefik’s server, i.e., repository, punches the ticket to determine access rights, whereas applicants’ destination computer responds to the embedded license stamp.
3. The license stamp and “ticket” are used at different times. In Stefik, the ticket is checked before the forwarding of a work. In applicant’s system, the license stamp is checked after the work has been received by the destination computer.

4. The effects of the ticket and license stamp are different. Stefik's ticket prevents the server from providing access, whereas applicant's license stamp prevents the receiver computer from carrying out actions on the file after it has already been received.

Each of these differences is sufficient to establish patentability of claims 1, 12 and 23.

Regarding the Examiner's citation of the software upgrade process described in col. 13 of Stefik, Applicant would note that this process is not a licensing process that controls access to a file, but rather is an authentication process to prevent the insertion of malicious software by an imposter. This purpose is very different and cannot be described as a "licensing" process, the subject of each of claims 1, 12 and 23.

Moreover, the dependent claims recite additional aspects that lend patentability.

Claims 3-6, 14-17, 24 and 25 depend on claim 1, 12 or 23 and are patentable over Stefik for similar reasons, and these claims further recite that the data file is a print file suitable for directly causing a printer to print a document defined by the print file. Stefik does not show or describe a print file, in any part of his disclosure. Rather, Stefik describes only files that a computer must convert to a print format, or software in the case of the col. 13 upgrade processes. To elaborate, a Microsoft word file or a text file must be converted to print control language to be printable directly. A print file contains print control language, and does not need such conversion.

The Examiner points to text in Stefik that mentions a printer or printing of content delivered by the Stefik method, but Stefik mentions nothing about print files of the type that can

be directly input to a printer, nor does Stefik describe embedding a license or any other content in a print file.

Claims 4, 15, and 25 are further patentable for their recitation that a license stamp is embedded in a print file in such a way that the printer would ignore it when printing the document. The Examiner points to Stefik at col. 48 lines 2-26 regarding this concept, but that section teaches to embed “tracer messages” that are printed in the document, albeit faintly or in a disguised manner – for the purpose of having a visible result in the printed document. This teaches away from embedding something in a print file so that it will not print.

Claims 5 and 16 further recite that the action carried out by the processing software (when processing a print file containing a license stamp) comprises displaying a representation of a document described by the print file on a computer monitor. There is nothing in Stefik like this. The Examiner points to Stefik at col. 4, line 32 regarding the possibility of displaying information, but that section does not deal with displaying a print file – a file that has commands for a printer. Nothing in Stefik suggests the display of the content of a print file on a display monitor.

Claims 7-10 and 18-21 depend on claims 1 or 12 and are patentable for that reason, and they further recite that the license stamp includes an attribute code and that the processing software in the destination computer refrains from processing the data file to carry out an action unless the attribute code has a determined value. The Examiner points to Stefik col. 3 lines 50-55 regarding this claim language, but this section only states that an owner of a digital work assigns usage rights that are kept in the source repository – it does not teach that destination

computer checks for an attribute code in a license stamp. As noted above, Stefik teaches only that the server computer, not the destination, checks licensing/usage rights on a work.

Claims 10 and 21 also recite that the number of bytes in the data file influences the value of an attribute in the license stamp. Although the Examiner points to Stefik Table 2 with regard to this language, that Table refers to information in the server computer not content of a license stamp embedded with a file. There is nothing to suggest what is recited in claims 10 and 21.

Claims 11 and 22 recite that a processing option code is included in the license stamp and influences the nature of the output of the processing software in the destination computer. The Examiner points to Stefik Table 2 regarding this language, but again, that Table relates to security levels assigned to a digital work that limit what the server computer can do with it, not what happens at a destination. There is nothing that teaches option codes that influence the output of processing software at a destination computer that receives and then processes a digital work.

Accordingly, Applicant submits that the Examiner's rejection is in error and a reversal of the rejection and allowance of the claims is therefore requested.

A Petition for Extension of Time is necessary to accompany this communication, please consider this paper a petition for such an extension of time. Authorization to charge a credit card will be provided in the EFS-WEB transmittal.

If any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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Claim Appendix

1. (Previously Presented) For a data file distribution and processing system including server software running on a source computer for sending data files to a destination computer via a network link between the source computer and the destination computer, and including processing software running on the destination computer for processing each data file forwarded thereto from said server software to carry out an action, a method for preventing the processing software running on the destination computer from processing data files forwarded to the destination computer other than from the server software, the method comprising the steps of:

including within the server software running on the source computer license stamping means for embedding a license stamp into each data file before the server software forwards the data file to said destination computer via said network link; and

adapting said processing software executed by said destination computer so that it processes each received data file to carry out said action only when the received data file contains the embedded license stamp, wherein the license stamp embedded in the data file indicates that the data file was forwarded by licensed server software.

2. (Original) The method in accordance with claim 1 wherein said encoded license stamp comprises a code identifying said source computer.

3. (Previously Presented) The method in accordance with claim 1 wherein said each data file, including its embedded license stamp, is a print file defining a document in a format suitable for directly causing a printer to print said document.

4. (Previously Presented) The method in accordance with claim 3 wherein said license stamping means embeds said encoded license stamp into each data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file.

5. (Original) The method in accordance with claim 3 wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file.

6. (Previously Presented) The method in accordance with claim 3 wherein said action carried out by said processing software comprises causing said printer to print said document.

7. (Original) The method in accordance with claim 1 wherein said data file defines a sound and wherein said action carried out by said processing software comprises a initiating said sound.

8. (Original) The method in accordance with claim 1 wherein said data file defines a video image and wherein the action carried out by said processing software comprises initiating a display of said video image.

9. (Previously Presented) The method in accordance with claim 1 wherein said license stamping means also processes said data file to determine a value of an attribute of the data file and includes in said embedded license stamp an attribute code indicating said value of said attribute, and wherein the method further comprises the step of

adapting the processing software to process the data file to determine a value of said attribute of the data file, and to refrain from processing the data file to carry out said action unless the received data file includes an embedded license stamp containing said attribute code indicating a value of said attribute matching the value of said attribute determined by said processing software.

10. (Original) The method in accordance with claim 9 wherein the data file processed by said license stamping means consists of a plurality of data bytes, each of which influences the value of said attribute determined by said license stamping means.

11. (Original) The method in accordance with claim 1
wherein said license stamping means includes a processing option code within said license stamp embedded within said data file, and

wherein the option code influences the nature of the output the processing software produces when processing the data file.

12. (Previously Presented) A data file distribution and processing system comprising:

a source computer;

a destination computer; and

network means for conveying data files from said source computer to said destination computer,

wherein said source computer executes server software for sending data files to the destination computer via said network means,

wherein said destination computer executes processing software for processing each data file forwarded thereto from said server software to carry out an action,

wherein said server software includes license stamping means for embedding a license stamp into each data file before the server software forwards the data file to said destination computer via said network means,

wherein said processing software processes each received data file to carry out said action only when the received data file contains the embedded license stamp, and

wherein the license stamp embedded in the data file indicates that the data file was forwarded by licensed server software.

13. (Original) The data file distribution and processing system in accordance with claim 12 wherein said encoded license stamp comprises a code identifying said source computer.

14. (Previously Presented) The data file distribution and processing system in accordance with claim 12 wherein each said data file, including its embedded license stamp, is a print file defining a document in a format suitable for directly causing a printer to print said document.

15. (Original) The data file distribution and processing system in accordance with claim 14 wherein said license stamping means embeds said encoded license stamp into the data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file.

16. (Original) The data file distribution and processing system method in accordance with claim 14 wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file.

17. (Previously Presented) The data file distribution and processing system in accordance with claim 16 wherein said action carried out by said processing software comprises causing said printer to print said document.

18. (Original) The data file distribution and processing system in accordance with claim 12 wherein said data file defines a sound and wherein said action carried out by said processing software comprises initiating said sound.

19. (Original) The data file distribution and processing system in accordance with claim 12 wherein said data file defines a video image and wherein the action carried out by said processing software comprises initiating a display of said video image.

20. (Previously presented) The data file distribution and processing system in accordance with claim 12

wherein said license stamping means also processes each said data file to determine a value of an attribute of the data file and includes in said embedded license stamp an attribute code indicating said value of said attribute, and

wherein the processing software processes each received data file to determine a value of said attribute of each data file received, and refrains from processing the received data file to carry out said action unless the received data file includes an

embedded license stamp containing said attribute code indicating a value of said attribute matching the value of said attribute determined by said processing software.

21. (Original) The data file distribution and processing system in accordance with claim 20 wherein the data file processed by said license stamping means consists of a plurality of data bytes, each of which influences the value of said attribute determined by said license stamping means.

22. (Original) The data file distribution and processing system in accordance with claim 12

wherein said license stamping means includes a processing option code within said license stamp embedded within said data file, and wherein the option code influences the nature of the output the processing software produces when processing the data file.

23. (Original) A data file distribution and processing system comprising:
first means for providing a data file;
second means for receiving the data file, for checking the data file to determine whether the data file contains an encoded license, and for thereafter processing the data file only when the data file contains the encoded license; and

third means for receiving the data file provided by said first means, for embedding said encoded license in the data file, and for forwarding said data file with the encoded license embedded therein to said second means, such that said encoded license indicates said data file as having been forwarded by said third means.

24. (Original) The data file distribution and processing system in accordance with claim 23 further comprising a printer,

wherein said data file provided by said first means is a print file suitable as input to said printer for instructing said printer to print a document, and wherein said third means processes said data file by displaying an image of said document and by transmitting said data file as input to said printer such that said printer prints said document in response to said print file.

25. (Original) The data file distribution and processing system in accordance with claim 23 wherein said second means embeds said encoded license into the data file in such a way that the printer ignores the encoded license when printing said document.

26. (Original) The data file distribution and processing system in accordance with claim 23 wherein said embedded license includes a code identifying a licensee.

Evidence Appendix

None.

Related Proceedings Appendix

None.